

Application No. : 10/692,835
Filed : October 23, 2003

REMARKS

Claims 70 – 77, 80 – 89, 91 – 95, and 98 – 102 were pending in the application. By this paper, Applicant has amended Claims 70, 80, 89 and 94, and added new Claims 103 – 105. Hence, Claims 70 – 77, 80 – 89, 91 – 95, and 98 – 105 are presented for examination herein.

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Drawings

Per page 2 of the Office Action, the drawings are objected to as failing to comply with 37 CFR 1.83(a). The Examiner states that the drawings fail to show the plurality of densities which are recited in Claims 92 and 93.

10 Applicant respectfully submits new drawing Fig. 3g. Support for this newly added figure can be found at, *inter alia*, page 26, lines 27 – 30 of Applicant's specification as filed which states: "*Furthermore it will be appreciated that the density of the foam may be adjusted and or varied as a function of location on each pad (or across different ones of individual pads), so as to tailor the pad apparatus 300 to the anatomy and various physical attributes of the animal on*
15 *which will be used.*" {Emphasis added}. Accordingly, Applicant submits new drawing Fig. 3g introduces no new matter.

§112 Rejections

Per page 3 of the Office Action, Claims 70 – 77, 80 – 86, 89, 94, 95 and 98 – 102 stand
20 rejected as failing to comply with the written description requirement of 35 U.S.C. §112.

Claim 70 – By this paper Applicant has amended Claim 70 to include limitations relating to the pads being placed at least partially within gaps or recesses in the withers region of the subject, the placement of the pads being such that the saddle and saddle pad apparatus is raised at
25 least partly off of only the withers region of the subject, so as to substantially avoid contact of the saddle with the top of the withers.

Support for this amendment may be found on page 24, lines 11 – 14 of Applicant's specification as filed. In particular, Applicant's specification states, "*the apparatus 300 strategically fills the gap(s) that naturally occurs on some horse's anatomies in the withers region,*
30 *thereby relieving this area from excess pressure and possible contact with the saddle in the gullet channel (caused by, e.g., an unbalanced saddle that is sitting too low in the hollows beneath the*

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withers)." {Emphasis added}. Stated differently, the specification appreciates an embodiment where pads are placed in the gaps of the withers region thus preventing contact in the withers region with the saddle and saddle pad apparatus. In order to prevent the contact referred to, the pads raise the saddle at least partly off the withers region of the subject.

5 It is noted that the Examiner's previous §112 rejection of Claim 70 is stated as being based on there being no support in the specification for Applicant's Claim 70 limitation "*partly off only said withers*." Claim 70 discloses a saddle pad apparatus comprising a plurality of pads that are placed at least partially within gaps or recesses in the withers region of the subject, the placement of the pads being such that the saddle and saddle pad apparatus is raised at least partly off of only said
10 withers region of the subject, so as to substantially avoid contact of said saddle with the top of the withers. The limitations of Claim 70 as amended are taught by Applicant's specification as filed. Accordingly, Applicant submits that the Examiner's §112 rejection of Claim 70 is rendered moot by the amendments affected by this paper; Applicant's amendments being fully supported by Applicant's specification as filed.

15 **Claim 80** – By this paper Applicant has amended Claim 80 to include limitations relating to the pads (of the saddle apparatus) further being disposed so as to elevate only a front portion of said saddle and saddle pad apparatus during riding.

Support for this amendment may be found on page 24, lines 11 – 14 of Applicant's
20 specification as filed. In particular, the specification states that "*the apparatus 300 strategically fills the gap(s) that naturally occurs on some horse's anatomies in the withers region, thereby relieving this area from excess pressure and possible contact with the saddle in the gullet channel (caused by, e.g., an unbalanced saddle that is sitting too low in the hollows beneath the withers).*" {Emphasis added}.

25 As discussed above, this excerpt from the specification indicates that Applicant specifically appreciated an embodiment of the present invention wherein the portion of the saddle and saddle pad apparatus which would otherwise come into contact with the withers would be elevated. (The aforementioned section of Applicant's specification expressly provides that the saddle and saddle pad apparatus will not come into contact with the animal's *withers region*; the withers region is
30 located near the front of an animal, thus it is the front portion of the saddle which must be elevated because it is that portion which would otherwise come into contact with the withers region.)

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Claim 80 as amended discloses a saddle apparatus comprising pads further being disposed so as to elevate only a front portion of the saddle and saddle pad apparatus during riding. The limitations of Claim 80 as amended are taught by Applicant's specification as filed. Accordingly, Applicant submits that the Examiner's §112 rejection of Claim 80 is rendered moot by the amendments affected by this paper.

Claim 89 – By this paper Applicant has amended Claim 89 to include limitations relating to the mounted ambulation of the equine. Support for this amendment may be found on page 24, lines 11 – 14 of Applicant's specification as filed.

Applicant notes that Claim 89 as amended also includes a limitation which the Examiner found not supported by the specification, specifically the limitation, "*prop up only a front portion*". In this regard, Applicant has amended Claim 89 to include a limitation which reads "*prop up only a front portion of saddle and saddle pad*". As discussed previously above, Applicant believes this aforementioned amendment is supported by Applicant's specification as filed (See e.g. page 24, lines 11 – 14) and renders the Examiner's § 112 rejection of Claim 89 moot.

Claim 94 – By this paper Applicant has amended Claim 94 to include limitations relating to the pad elements and pad being disposed within gaps created by said withers region and cooperatively forming a raised feature element to raise only a frontal portion of a saddle and said apparatus disposed over top of said pad elements with respect to a withers region.

Applicant contends that support for this limitation may be found on page 24, lines 11 – 14 of Applicant's specification as filed. In particular, Applicant's specification states that "*the apparatus 300 strategically fills the gap(s) that naturally occurs on some horse's anatomies in the withers region, thereby relieving this area from excess pressure and possible contact with the saddle in the gullet channel (caused by, e.g., an unbalanced saddle that is sitting too low in the hollows beneath the withers).*" {Emphasis added}. As discussed above, the abovementioned section of the specification illustrates an appreciation of an embodiment of the present invention wherein the pads are disposed within the gaps created by the withers region and cooperatively forming a raised feature element to raise only a frontal portion of a saddle and said apparatus; placement of the pads in the withers region would, as discussed above, result in a raising of only a

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frontal portion of the saddle and apparatus, i.e. the portion of the saddle that would otherwise come into contact with the withers region. Accordingly, Applicant submits that the Examiner's §112 rejection of Claim 94 is rendered moot by the amendments affected by this paper; Applicant's amendments being fully supported by Applicant's specification as filed.

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§102 Rejections

Per page 4 of the Office Action, Claims 70 – 75 and 91 – 93 each stand rejected under 35 U.S.C. §102 as being anticipated by Vasko, et al. (U.S. Patent No. 4,683,709, hereinafter "Vasko").

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Claim 70 – By this paper, Applicant had previously amended Claim 70 to include limitations relating to the pads placed at least partially within gaps or recesses in the withers region of the subject, the placement of the pads being such that the saddle and saddle pad apparatus is raised at least partly off the withers region of the subject, so as to substantially avoid contact of said saddle with the top of the withers.

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Applicant submits that Vasko does not teach or suggest pads placed at least partially within gaps or recesses in the withers region of the subject, the placement of the pads being such that the saddle and saddle pad apparatus is raised at least partly off the withers region of the subject.

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The Examiner states "*the pads of Vasko et al. are also configured to raise the saddle at least partly off of only the withers region of the animal if one wishes to do so by only employing the front pads of the multiple pads as stated in col. 5, lines 1 – 10.*"

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However, Applicant notes that the teachings of the Vasko disclosure pointedly teach away from employing *only* the front pads of the multiple pad embodiment disclosed. Vasko, in Applicant's view, merely intimates that the number of pads may vary, not that portions of the pockets may remain unfilled as is implied by the Examiner. Specifically, Vasko states that in the "*present invention an improved saddle pad for use on a horse is provided for minimizing the amount of shock or energy transferred between the horse and its rider or other such load.*" See Col. 1, lines 26 – 29. To accomplish the foregoing, the invention states that:

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"The pad is then aligned upon the horse's back such that the centerline stitching 26 is adjacent and parallel to the horse's spinal vertebrae. The pockets are located immediately adjacent to and on each side of the centerline 26 so as to

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5 *hold the inserts 36 and 38 parallel to and in immediate proximity to the horse's spine. This allows the load of the rider and the accompanying shock or energy transfers to be evenly distributed along the horse's back avoiding any undue abrasion of the thoracic spinal vertebrae.” Col. 3, lines 21 – 31 of Vasko {Emphasis added}.*

10 Thus, Vasko teaches a pad which seeks to evenly distribute the load along the horse's back. The Examiner appears to contend that it would have been obvious to modify the teachings of Vasko to render unpatentable Applicant's Claim 70 invention, specifically by only employing the front pads in Vasko and leaving other pockets unfilled. Applicant contends that this specific embodiment is not disclosed by Vasko and that modifying Vasko by only employing the front pads of the multiple pad embodiment is contrary to the intended purpose of the Vasko invention. The MPEP states at Chapter 2143.01 *“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or*
15 *motivation to make the proposed modification.”* See also *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). As discussed above, the intended purpose of the Vasko invention is to evenly distribute the load along the horse's back. Employing only the front pads in Vasko such that the saddle is raised at least partly off the withers region of the subject would render Vasko unsatisfactory for evenly distributing the load. Therefore, the Examiner's proposed modification is, in Applicant's view,
20 improper. It is clear that to employ only front pads such that the saddle and saddle pad apparatus is raised at the withers region is directly contrary to the solution proposed by Vasko (i.e. the load would no longer be evenly distributed). Hence, Applicant contends that Vasko simply does not teach or suggest every element of Claim 70.

25 Lastly, Applicant notes that “[a] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” *In re Spinnable*, 405 F.2d 578, 585 (CCPA 1969). Applicant submits that the precise problem to be addressed by the invention of Claim 70 is one of supporting a saddle while maintaining both substantially
30 unimpeded movement of the spinal column of a living subject and substantially eliminating pressure points in the withers region of the subject. The teachings of Vasko are aimed at distributing the load evenly along the horse's back. It in no way recognizes the problem identified and solved by Applicant's invention; i.e., selectively placing pads at least partially

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within the withers region such that the saddle is raised at least partly off the withers region of the subject.

Applicant herein notes with respect to the Examiner's comment on page 19 of the Office Action that states:

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"All other arguments regarding Applicant's statement of 'solving a source of a problem' are addressed similar to the above comments. Again, there is no evidence provided by Applicant as required by MPEP 2100 to state the source of the problem and those in the same field of endeavor have repeatedly tried and failed to solve the problem";

Further, the Examiner has stated that MPEP § 2141.02 states "*Applicants who allege they discovered the source of a problem must provide evidence substantiating the allegation, either by way of affidavits or declarations, or by way of a clear and persuasive assertion in the*

15 *specification. In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979)." (Emphasis added)

Applicant submits that clear and persuasive assertions are replete throughout Applicant specification as filed which indicate Applicant's discovery of the source of a problem. For example, Applicant directs the Examiner's attention to, *inter alia*, page 2 lines 3 – 23, page 24 lines 10 – 15, page 25 lines 3 – 4, and page 28 lines 13 – 19 of Applicant's specification as filed.

20 Thus, Applicant contends that the Examiner's assertion that Applicant's specification does not provide clear and persuasive assertions of the discovery of the source of a problem separate from the problem solved by the prior art is respectfully without merit.

Accordingly, for the foregoing reasons, Applicant submits that Claim 70 as amended herein is in condition for allowance.

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Claim 91 – Applicant respectfully traverses the Examiner's rejection of Claim 91. The Examiner states that the terms 'adapted' and 'shaped to accommodate and fit substantially within' comprise "*functional recitation...to which the pads of Vasko et al. are capable of performing.*" The Examiner then appears to utilize these functional terms to completely discount

30 the structure recited in conjunction with this functional language. Per MPEP §2114 "*a claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior*

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art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)."

Here, Applicant contends that Claim 91 is not anticipated by Vasko because Vasko fails to teach all of the structural limitations of the claim. Specifically, Claim 91 recites a pad element having a specific structural limitation, that limitation being that the pad is shaped to substantially accommodate and substantially fit within a particular withers region recess on the anatomy of an animal. Although function flows naturally from this recitation of structure, the fact remains that the invention of Claim 91 requires pads having a particular structure (i.e., shape). Applicant can find no support in Vasko for the proposition stated by the Examiner; i.e., that "*Vasko et al. teaches a pad element...particularly shaped to substantially accommodate and fit substantially within a particular withers region recess on the anatomy of an animal on which said pad element and saddle pad is utilized.*" {Emphasis added}. Should the Examiner maintain his argument in this regard, Applicant respectfully requests that he provide specific citations to Vasko where such structure is taught.

§103 Rejections

Per page 7 of the Office Action, Claims 76, 77, 80 – 89, 94, 95, 98 – 102 each stand rejected under 35 U.S.C. §103 as being unpatentable over Vasko in view of Woods (US Patent No. 5,802,823, hereinafter "Woods").

Claim 80 – As noted above, Applicant has by this paper amended Claim 80 to include limitations relating to the pads (of the saddle apparatus) further being disposed so as to elevate only a front portion of said saddle and saddle pad apparatus during riding.

Applicant respectfully traverses any rejection the Examiner's may raise with regard to amended Claim 80 as being unpatentable over Vasko in view of Woods.

Vasko does not teach a saddle pad apparatus comprising a plurality of pads being disposed so as to elevate only a front portion of said saddle and saddle pad apparatus during riding as described in Claim 80 as amended. Per MPEP § 2143.03, a prior art reference (or combination of references) must teach or suggest all the claim limitation to render a claim obvious. Since each and every claim element has not been met by the prior art as required, amended Claim 80 is not rendered obvious.

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The Examiner goes on to state, "*it would have been obvious to one having ordinary skill in the art at the time the invention was made to only employ the pads of Vasko et al. in the front portion depending on where the user wishes to have the cushion effect of the pad, in the front or back or both.*" Applicant respectfully contends that this modification and/or interpretation of the teachings of Vasko is improper.

Applicant notes that Vasko pointedly *teaches away* from employing *only* the front pads of the multiple pad embodiment disclosed. Specifically, Vasko states that the "*present invention an improved saddle pad for use on a horse is provided for minimizing the amount of shock or energy transferred between the horse and its rider or other such load.*" See Col. 1, lines 26 – 29.

To the accomplishment of this purpose, the invention then utilizes pads which are "*aligned upon the horse's back such that the centerline stitching 26 is adjacent and parallel to the horse's spinal vertebrae. The pockets are located immediately adjacent to and on each side of the centerline 26 so as to hold the inserts 36 and 38 parallel to and in immediate proximity to the horse's spine. This allows the load of the rider and the accompanying shock or energy transfers to be evenly distributed along the horse's back avoiding any undue abrasion of the thoracic spinal vertebrae.*" See Col. 3, lines 21 – 31. Thus, Vasko teaches a pad which seeks to evenly distribute load along the horse's back. It is clear that to employ only front pads (leaving pockets empty) to elevate only a front portion of said saddle is directly contrary to the solution proposed by Vasko. Hence, Applicant contends that not only does Vasko not teach or suggest every element of amended Claim 80, but it further teaches away from such configuration.

Accordingly, for at least the foregoing reasons, Applicant submits that Claim 80 as amended is both novel and non-obvious over both Woods and Vasko and thus is respectfully in condition for allowance.

Claim 87 – Applicant respectfully traverses the Examiner's rejection of Claim 87 as being unpatentable over Vasko in view of Woods.

The Examiner states, "*Vasko et al teach a saddle pad...wherein said pad elements are disposed and configured to substantially fill respective ones of gaps that occur on the anatomy of said high-withered equine in its withers region...*"

Applicant contends that Vasko fails to teach the above stated element. Specifically, Claim 87 recites a pad element being disposed and configured to substantially fill respective ones of

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gaps that occur on the anatomy of a high-withered equine in its withers region. Applicant can find no support in Vasko for the proposition stated by the Examiner, i.e., that Vasko teaches disposing the pads within the withers region gaps. Neither is there support found to the pads configured to substantially fill the withers region gaps. Should the Examiner maintain his argument in this regard, Applicant respectfully requests that he provide specific citations to Vasko where such structure is taught.

Claim 89 – As discussed above, by this paper Applicant has amended Claim 89 to include a limitation which reads “*prop up only a front portion of saddle and saddle pad*”. As discussed previously above, Applicant believes this aforementioned amendment is supported by Applicant’s specification as filed. Support for this amendment may be found on page 24, lines 11 – 14 of Applicant’s specification as filed. Applicant respectfully submits that Applicant’s amended distinguishes over both Woods and Vasko.

The Examiner states, “*Vasko et al. teaches a saddle pad...wherein said pad elements are adapted to interface only with gaps formed in the withers region of said equine so as to prop up only a front portion of said saddle...*” Applicant contends that Vasko fails to teach the abovementioned limitations. Vasko teaches pad elements that cover substantially most of the equine’s back (whether with two or more inserts) and accordingly would not prop up only a front portion of saddle and saddle pad apparatus.

The Examiner further states, “*it would have been obvious to one having ordinary skill in the art at the time the invention was made to only employ the pads of Vasko et al. in the front portion depending on where the user wishes to have the cushion effect of the pad, in the front or back or both.*” Applicant respectfully argues, however, that is not obvious to employ the pads of Vasko in such a way. A modification of a prior art reference is improper where the prior art reference teaches away from the proposed modification. Applicant contends that Vasko teaches away from an embodiment wherein pads interface only with gaps formed in the withers region as Vasko is concerned with evenly distributing the load along the horse’s back. See e.g. Col. 3, lines 21 – 31 of Vasko. Accordingly, for at least the foregoing reasons, Applicant submits that amended Claim 89 possesses novelty over both Woods and Vasko, whether alone or in combination, and thus is in condition for allowance.

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Claim 94 – By this paper Applicant has amended Claim 94 to include limitations relating to the apparatus wherein the pad elements and pad are disposed within gaps created by said withers region and cooperatively forming a raised feature element to raise only a frontal portion of a saddle and said apparatus disposed over top of said pad elements with respect to a withers region. As previously discussed, Applicant believes the aforementioned amendment distinguishes over Vasko and Woods in that neither Vasko nor Woods teaches or suggests forming a raised feature element to raise only a frontal portion of a saddle and apparatus with respect to a withers region. Accordingly, Applicant submits that Claim 94 is in condition for allowance.

10 *New Claims*

By this paper, Applicant has added new Claims 103 – 105. Applicant submits that each of these new claims is fully supported by the specification as filed, and hence no new matter has been added.

Specifically, new Claim 103 generally corresponds to the subject matter of Claim 70 as well as page 24, lines 6 – 14 of Applicant's specification as filed; new Claim 104 generally corresponds to the subject matter of Claim 87 as well as page 24, lines 6 – 14 of Applicant's specification as filed; new Claim 105 generally corresponds to the subject matter of Claim 89 as well as page 24, lines 6 – 14 of Applicant's specification as filed.

Moreover, Applicant respectfully submits that each new claim defines patentable subject matter, in that *inter alia* neither Vasko nor Wood teaches or suggests the limitations found in each new claim.

Other Remarks

Applicant hereby specifically reserves the all rights of appeal (including those under the Pilot Appeal Brief program), as well as the right to prosecute claims of different or broader scope (including those of non-elected inventions) in a continuation or divisional application.

Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any

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claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, based on such cancellations or additions.


Furthermore, any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

5 If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

Respectfully submitted,
GAZDZINSKI & ASSOCIATES

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Dated: January 24, 2008

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